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10/752,396	01/06/2004	Luis Eduardo Gutierrez-Sheris	25153-014	3579
32137 7590 02/02/2010 PATENT DOCKET CLERK COWAN, LIEBOWITZ & LATMAN, P.C. 1133 AVENUE OF THE AMERICAS NEW YORK, NY 10036				
EXAMINER WINTER, JOHN M.				
ART UNIT 3685		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Office Action Summary****Application No.**

10/752,396

**Applicant(s)**GUTIERREZ-SHERIS, LUIS  
EDUARDO**Examiner**

JOHN M. WINTER

**Art Unit**

3685

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 38-63,65-76,78-85 and 88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 38-63,65-76,78-85 and 88 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/2/2009 and 12/17/2009
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Acknowledgements***

1. The Applicants amendment filed on August 27, 2009 is hereby acknowledged. Claims 38-63, 65-76, 78-85 and 88 are pending. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on August 27, 2009 has been entered.

### ***Response to Arguments***

Applicant's arguments with respect to the pending claims have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claims 38-63, 65-85 and 88 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

3. Based on Supreme Court precedent (See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63,

70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. In addition, the tie to a particular apparatus, for example, cannot be mere extra-solution activity. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed. In this particular case, claim 38 fails prong (1) because the “tie” (e.g. fund access device) is representative of extra-solution activity. Additionally, the claim(s) fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

4. Claims 39-63, 65-76, 78-85 and 88 are also rejected as each depends from claim 38 or contains similar limitations.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a

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person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 38-63, 65-76, 78-85 and 88 are rejected under 35 U.S.C. 103(a) as being obvious in view of Walker et al. (U.S. Patent 6,163,771) in view of Gifford (US Patent 6,049,785) and further in view of Curry et al. (US Patent 5,949,880).

6. As per claim 38, 49, 60 and 73

Walker et al. discloses a method for accessing funds associated with a financial instrument, comprising:

generating a funds-access code (Abstract) including the steps of

creating and storing a record containing the generated fund-access code and accompanying information about a recipient in a database on a computer readable medium accessible to a network attached computer, (Column 7, lines 20-45) and linking the fund-access code record to a financial instrument containing funds; (Figure 6, private key and nonce in relation to account number)

supplying the funds-access code to the recipient; (Column 6, lines 15-29)

presenting the funds-access code by the recipient to a distributor; (Column 6, lines 15-29)

linking the funds-access device record to the financial instrument that is currently linked to the fund access code record; (column 6, lines 39-53)

comparing the transmitted fund-access code and recipient information with the information in the fund-access code record in the database, and receiving by the distributor confirmation of the validity of the presented fund-access code via the remote network attached computer (Column 12, lines 19-45).

Walker et al. does not explicitly disclose “activating by the distributor a carryable funds-access device after receiving confirmation of the presented fund-access code including the steps of activating one of multiple inactive carryable funds-access devices located at the distributor’s location, creating and storing a funds-access device record representing the activated funds-access device in the database; presenting the recipient with the activated find-access device”. Gifford discloses “activating by the distributor a carryable funds-access device after receiving confirmation of the presented fund-access code including the steps of activating one of multiple inactive carryable funds-access devices located at the distributor’s location, creating and storing a funds-access device record representing the activated funds-access device in the database presenting the recipient with the activated find-access device” (Column 5, lines 49-61; Column 11, lines 29-41; figure 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al. method with the Gifford method in order in order to allow spontaneous purchasing.

Walker et al. does not explicitly disclose “generating a random code that is the funds-access code; validating the presented funds-access code including the steps of transmitting by the distributor the presented fund-access code and recipient information via a remote network attached computer, comparing the transmitted fund-access code and recipient information with the information in the fund-access code record in the database, and receiving by the distributor confirmation of the validity of the presented fund-access code via the remote network attached computer and utilization of the activated funds-access device by the recipient; accessing by the

recipient of the funds within the financial instrument using the funds access device at an automatic teller machine disposed at a location remote from a location of the distributor.

”, Curry et al. ('880) discloses ““generating a random code that is the funds-access code; (column 6, lines 6-30 [examiner notes that the “Random SALT value added to the transaction block data effectively randomized the data]) validating the presented funds-access code including the steps of transmitting by the distributor the presented fund-access code and recipient information via a remote network attached computer, (column 7, lines 14-37) and utilization of the activated funds-access device by the recipient; accessing by the recipient of the funds within the financial instrument using the funds access device at an automatic teller machine disposed at a location remote from a location of the distributor.”(Figure 1, column 2, lines 30-45). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the Walker et al. in view of Gifford with Curry et al. ('880)' teaching in order in order to allow secure purchasing of products.

7. As per claims 39, 50, 61 and 74,

Walker et al. discloses the method of claim 38, wherein the financial instrument is an instrument representative of a funds-transfer (column 3, lines 59-64 -- i.e. making a purchase) .

8. As per claims 40, 51, 62 and 75,

Walker et al. discloses the method of claim 38,

wherein the financial instrument is a check, and the funds-access code is a check number (Figures 11a and b – the process is analogous to using a check number).

9. As per claims 41, 52, 65 and 78

10. Walker et al. discloses the method of claim 38, wherein the funds-access device is a carrying card having a magnetic stripe containing data; and the step of accessing the funds is carried out upon reading the data from the magnetic stripe on the carrying card.(Column 5, line 51)

11. As per claims 42, 53, 66 and 79, Walker et al. discloses the method of claim 38, wherein the step of activating a funds-access device further includes the step of providing the recipient with a personal code, and wherein the step of accessing the funds is carried out by utilizing the funds-access device and providing the personal code by the recipient. (Column 6, lines 39-53)

12. As per claims 43, 54, 67 and 80, Walker et al. discloses the method of claim 42, wherein the funds, access device is an ATM card usable at automatic teller machines and the personal code is a PIN; and wherein the step of accessing the funds is carried out by the recipient supplying the ATM card and the PIN to one of the automatic teller machines.



(Column 6, lines 39-53)

13. As per claims 44, 55, 68, and 88, Walker et al. discloses the method of claim 43, wherein the step of accessing the funds is carried out by the steps of requesting by the recipient a designated amount of cash, dispensing by the automatic teller machine the requested cash, and updating the financial instrument associated with the funds to reflect dispensing of the designated amount of cash to the recipient. (Column 6, lines 39-53)

14. As per claims 45, 56, 69 and 82, Walker et al. discloses the method of claim 38, further comprising the steps of storing the financial instrument and the funds-access device in a relational database (Figure 12).

15. As per claims 46, 57, 70 and 83, Walker et al. discloses the method of claim 38, further comprising the steps of specifying a selected recipient by the financial instrument and associating the financial instrument with a receiving financial instrument identity record identifying the recipient. (Column 6, lines 39-53)

16. As per claim 47, 58, 71 and 84, Walker et al. discloses the method of claim 46,

further comprising the step of verifying by the distributor a matching of the identity of the recipient to an identity identified by the receiving financial instrument identity record of the financial instrument associated with the supplied funds access code, and wherein the steps of activating and accessing steps are carried out only if the match is verified (Figures 11 A and 11B).

17. As per claim 48, 59, 72 and 85,  
Walker et al. discloses the method of claim 47,  
wherein the financial instrument, the funds-access device record, and the receiving financial instrument identity record are stored in a relational database (Figure 12).

18. As per claims 63 and 76,  
Walker et al. discloses the method of claim 60,  
Official Notice is taken that “depositing step is carried out by an agent of a bank” is common and well known in prior art in reference to banking protocols. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a banking agent to make a deposit in order to prevent fraudulent transactions.

### ***Conclusion***

19. Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN M. WINTER whose telephone number is (571)272-6713. The examiner can normally be reached on M-F 8:30-6, 1st Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Calvin Hewitt can be reached on (571) 272-6709. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JMW

/Calvin L Hewitt II/  
Supervisory Patent Examiner, Art Unit 3685